REMARKS

STATUS OF THE CLAIMS

[0001] Claims 1, 3-6, 8, 10-18, 20, 21, and 23 remain in the case. Claims 1, 3-6, 8, 10-18, 20, 21, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 7,080,104 to Ring et al. [hereinafter "*Ring*"] in view of U.S. Patent No. 7,007,041 to Multer, et al. [hereinafter "*Multer*"]. Claims 1, 8, 16, 17, and 20 have been amended. No new claims have been added. No new matter has been added.

RESPONSE TO CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

[0002] The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *See* MPEP § 2142. *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966) sets forth the factual inquiry necessary to determine obviousness. The Examiner must: determine the scope and contents of the prior art; determine the differences between the prior art and the claims at issue; resolve the level of ordinary skill in the pertinent art; and consider objective evidence present in the application indicative of obviousness or nonobviousness. Applicants respectfully assert that the Office Action fails to establish a *prima facie* case of obviousness in light of the amended claims. First, not all elements of the amended claims are taught or suggested in the art of record, and second, the art of record teaches away from the Applicants' claimed invention. Applicants respectfully submit that *Ring* and *Mulder* do not teach the validation module of the amended claims, and further that *Ring* and *Mulder* both teach away from the inclusion of a validation module, and from user interaction in general.

[0003] To highlight the differences between the present invention and the cited prior art, as mandated by *Graham*, a summary of the claimed invention and of the prior art may be useful. Generally, the claimed invention seeks to overcome problems of the prior art associated with creating an interactive messaging contact list. Application at ¶¶ 2-5. As amended, Applicants' claimed invention solves these problems by retrieving a user's contact information, validating that information both with the user and with an interactive messaging server, and inserting the validated information into an interactive messaging contact list. *Id.* at ¶ 6-7.

[0004] More specifically, a retrieval module retrieves contact information of online users from a plurality of contact sources on a user's computer. *Id.* at ¶ 7, 26-28, 30, 34. A validation module v**erifies** which of the online users are v**alid users of an interactive messaging service** provided by a messaging server, **interactively prompts the user during a single online session** to accept or reject the contact information for each valid user, and **provides validated contact information**. *Id.* at ¶ 7-11, 28, 31-32, 35. An insertion module adds the validated contact information to an interactive messaging contact list. *Id.* at ¶ 7-9, 28, 31-32, 35.

[0005] By interactively prompting a user to resolve conflicts, the present invention provides a user with significant control over the compilation process, particularly when combining contact information from multiple lists. The invention contemplates real-time interactive input from the user. The claims have been previously amended to make this point clear.

[0006] Additionally, by v**alidating each online user with a messaging server** to determine which of the online users are valid users of an **interactive messaging service**

provided by the messaging server, and presenting **valid users** to the user to accept or reject, the interactive messaging contact list will automatically comprise valid users of the messaging service, thus increasing the utility of the interactive messaging contact list and of the claimed invention. Independent Claims 1, 8, 16, 17, and 20 have been amended to emphasize this point, which is supported in at least paragraphs 7-11, 28, 31-32, and 35 of the Application.

Ring

[0007] *Ring*, in general, teaches synchronizing data folders between layers of folders or between folders on a network. *Ring* at Title, Abstract. *Ring* teaches synchronization that is automatic, and repeatedly teaches away from user intervention or interaction. *Id.* at column 3, lines 26-32; column 4, lines 61-65; columns 6, lines 11-15. For example, in lines 27-32 of column 3, *Ring* teaches "synchroniz[ing] data… with nominal or no need for user intervention" as well as "merg[ing] data… with nominal or no need for user intervention." Instead of resolving conflicts interactively with a user, or customizing the synchronization, *Ring* teaches automatically resolving conflicts without user input, or merely informing the user of a conflict by email. *Id.* at column 19, line 61 – column 20, line 2.

Multer

[0008] *Multer*, in general, teaches the synchronization and transference of data between two systems or devices. *Multer* at Abstract, column 1, lines 20-24. *Multer* teaches synchronizing data across multiple independent systems or devices using a difference engine so that data that has changed will be transferred. *Id.* at column 5, lines 36-56. *Multer* teaches

that prior art synchronization systems are inefficient, because they "require interaction by the user" "at some level." *Id.* at column 2, lines 46-51.

[0009] Both prior art references, *Ring* and *Multer*, clearly teach away from user interaction. In fact, the portion of *Multer* cited in the Office Action as teaching "interactively prompt[ing] the user during a single online session to accept or reject the contact information for each online user" of Applicants' Claim 1, is found in a list of **inefficiencies in the prior art**, stating that systems that synchronize data over direct cable connections "require interaction by the user" "at some level," likely referencing the need for a user to manually plug in a cable. *See* Office Action, pg. 3, par. 5, referencing *Multer,* column 2, lines 47-50.

[0010] Applicants respectfully submit that the teachings of *Multer* not read on the claimed invention, failing to teach or suggest an **online session**, **interactively prompting a user**, and **accepting or rejecting contact information**. Additionally, *Multer* teaches away from the claimed invention and user interaction in general in the very excerpt referenced in the Office Action.

[0011] The Supreme Court, in *KSR Int'l Co. v. Teleflex Inc.,* stated that "when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. _____, 82 USPQ2d 1385, 1395 (2007). Applicants submit that neither prior art references teaches "interactively prompt[ing] the user during a single online session to accept or reject the contact information for each online user" of Applicants Claim 1 and similar limitations in independent Claims 8, 16, 17, and 20. Applicants further submit that the fact

that both prior art references teach away from user interaction in general is strong evidence of nonobviousness.

[0012] To further distinguish the claimed invention from the prior art of reference, and to facilitate prompt discovery of allowable subject matter, Applicants have amended independent Claims 1, 8, 16, 17, and 20 to include "verify[ing] which of the online users are valid users of an interactive messaging service provided by a messaging server" and further providing "validated contact information comprising the contact information for the online users who are valid users and are accepted by the user." Amended Claim 1. Applicants submit that the server of *Ring* does not **provide an interactive messaging service**, and does not **verify which online users are valid users of an interactive messaging service**.

[0013] The relevant portion of *Ring* cited in the Office Action to teach the claimed validation module of Claim 1 states that "the server system 112 provides the member 104 an option to fix [a conflict] by replying to the email or by logging into a web site for the service (PNS) and choosing the correct actions." Office Action, page 3, paragraph 1; *Ring*, column 19, lines 66-67 – column 20, lines 1-2. The server of *Ring* resolves conflicts in contact information through non-interactive emails, but does not provide an interactive messaging service, or verify which online users are valid users of an interactive messaging service.

[0014] Applicants respectfully assert that Claim 1 is in condition for allowance. Similarly, Applicants assert that the arguments in favor of Claim 1 are equally applicable to Claims 8, 16, 17, and 20, which are in condition for allowance. Claims 3-6, 10-15, 18, 21, and 23 depend on Claim 1, 8, 16, 17, and 20. Because the invention of Claims 1, 8, 16, 17, and 20 are not obvious in relation to *Ring* and *Multer*, the Applicants respectfully assert that Claims 3-6, 10-15, 18, 21, and 23 are similarly in condition for allowance because they

depend from allowable claims. See *in re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

[0015] Applicants have amended Claims 1, 8, 16, 17, and 20 and cancelled claims 2, 7, 9, 19, and 22 from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the allowable subject matter noted by the examiner. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

[0016] Should additional information be required, the Examiner is respectfully asked to notify the Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,

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